

## **REMARKS**

The Office Action dated December 11, 2003, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 23-31 are pending and respectfully submitted for consideration.

Claims 23-27, 30 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Arita (U.S. Patent No. 5,821,926) in view of Gasperina (U.S. Patent No. 5,491,781). The Office Action took the position that Arita discloses many of the claimed elements of the invention with the exception of magnifying only the selected button into a predetermined size in longitudinal and lateral directions and displaying the magnified button. Gasperina was cited for curing this deficiency. Claims 24-27 depend from claim 23 and claim 31 depends from claim 30. The Applicants submit that claims 23-27, 30 and 31 recite subject matter that is neither disclosed nor suggested by the cited prior art. In particular, Gasperina fails to cure the deficiencies in Arita with respect to claims 23 and 30.

Claim 23 recites magnifying only the selected button, into a predetermined size in longitudinal and lateral directions and displaying the magnified button. Claim 30 recites magnifying in longitudinal and lateral direction and displaying the selected button upon a single user action. As a preliminary matter, Gasperina does not disclose a "button in said toolbar" as recited in claims 23 and 30.

Also, Gasperina does not disclose magnifying only the selected button, into a predetermined size in longitudinal and lateral directions and displaying the magnified button as recited in claim 23. Also, Gasperina does not disclose magnifying in

longitudinal and lateral direction and displaying the selected button upon a single user action as recited in claim 30. In contrast, Gasperina discloses that “[d]ragging a handle to change the length of the scroll box in a given dimension thus adjusts the scale of the displayed data in that dimension.” (Emphasis added). The Applicants submit that Gasperina does not disclose that a “window 12” itself can be magnified.

In addition, the Applicants respectfully submit that Gasperina fails disclose a toolbar on a screen as recited in claims 23 and 30. In contrast, Gasperina merely discloses a scroll box 16 or 18, which is not displayed on a screen and is only changed in one direction, either lateral or longitudinal, but not lateral and longitudinal. Therefore, Gasperina also fails to disclose magnifying only the selected button, into a predetermined size in longitudinal and lateral directions as required by claim 23, and magnifying in longitudinal and lateral direction and displaying the selected button upon a single user action as recited in claim 30. Accordingly, Gasperina fails to cure the Examiner admitted deficiencies in Arita with respect to claims 23 and 30.

The Applicants also submit that Arita, Gasperina, and the prior art in general do not provide a motivation for modifying Arita in the manner suggested by the Office Action. The Office Action, on page 4, states that it would have been obvious to one of ordinary skill in the art to implement Gasperina's teachings into the computer system of Arita *“to displaying information because it would have capable correcting reproduced image density automatically in accordance with a density of document ground.”* The Applicants point out that neither Arita nor Gasperina provide this teaching, which in a previous Office Action, was taken from a reference that was withdrawn as not valid prior art, and therefore, the teachings of that reference are not applicable to the present

invention. As such, there Office Action has not set forth the required motivation for combining the references' teachings. Accordingly, the Applicants respectfully request withdrawal of the rejection of claims 23-27, 30 and 31 in view of the Arita and Gasperina references.

Claims 28 and 29 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Arita and Gasperina and further in view of Schindler et al (U.S. Patent No. 5,675,390, "Schindler"). Arita and Gasperina are cited for disclosing many of the claimed elements of the invention with the exception of using a remote control. Schindler was cited for curing this deficiency. Claims 23 and 29 are independent. Claim 28 depends from claim 23. The Applicants respectfully submit that claims 28 and 29 recite subject matter that is neither disclosed nor suggested by the cited prior art.

With respect to claim 29, the Applicants respectfully submit that the combination of Arita, Gasperina and Schindler fails to disclose or suggest the claimed features of the invention. Claim 29 recites magnifying only the selected button into a predetermined size in longitudinal and lateral directions and displaying the magnified button. As acknowledged in the Office Action, Arita fails to disclose not only a remote control, but also fails to disclose magnifying only the selected button into a predetermined size in longitudinal and lateral directions. Gasperina was cited for teaching the step of magnifying. However, Gasperina and Schindler do not disclose magnifying in longitudinal and lateral direction and displaying the selected button upon a single user action, as recited in claim 30. As such, Gasperina fails to disclose magnifying the selected button in longitudinal and lateral directions as recited in claim 29. Schindler also does not disclose magnifying the selected button in longitudinal and lateral

directions, and therefore, fails to cure the deficiencies in Arita and Gasperina. Accordingly, the combination of Arita, Gasperina and Schindler fails to disclose or suggest each and every feature of the invention as recited in claim 29.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

In view of the above, the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claims 23-31 under 35 U.S.C. §103.

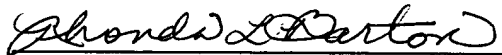
For at least the combination of foregoing reasons the Applicants respectfully submit that Arita, Gasperina and Schindler, either singly or in combination, fails to disclose or suggest the present invention as claimed in claims 23-31, and further are not properly combinable to render claims 23-31 obvious.

Claims 24-28 depend from claim 23 and claim 31 depends from claim 30. The Applicants respectfully submit that these dependent claims are allowable at least because of their dependency from allowable base claims 23 and 30. Accordingly, the Applicants respectfully requests allowance of claims 23-31 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt. No. 101216-09002.

Respectfully submitted,



Rhonda L. Barton  
Attorney for Applicants  
Registration No. 47,271

Customer No. 004372  
ARENT FOX PLLC  
1050 Connecticut Avenue, N.W., Suite 400  
Washington, D.C. 20036-5339  
Tel: (202) 857-6000  
Fax: (202) 638-4810

RLB/wbp